

## **REMARKS**

Applicant respectfully requests entry of the following amendments and remarks in response to the Office Action mailed June 5, 2008. Applicant respectfully submits that the amendments and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 1 – 4, 6 – 11, 13 – 19, 21 – 27 and 29 are pending. In particular, Applicant amends claims 16 – 19, 21 – 22, 25 – 27, and 29. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **I. Objections to the Drawings**

The Office Action indicates that the drawings are objected to under 37 CFR 1.83(a). The Office Action argues that drawings must show every feature of the invention specified in the claims. Applicant respectfully traverses this objection for at least the reason that 37 C.F.R. §1.81 states “ [t]he [A]pplicant for a patent is required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be patented” (emphasis added). Applicant respectfully submits that 37 C.F.R. §1.83 must be read in conjunction with 37 C.F.R. §1.81 and that even if the examiner is unable to find these features in the drawings, Applicant submits that a drawing that includes these features is not needed for understanding of the claimed subject matter. For at least these reasons, Applicant respectfully traverses this objection.

### **II. Rejections Under 35 U.S.C. §101**

The Office Action indicates that claims 16 – 19, 21 – 22, 25 – 27, and 29 stand rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Applicant amends claims 16 – 19, 21 – 22, 25 – 27, and 29, as indicated above. Applicant submits that

these amendments comply with the Office Action request and that claims 16 – 19, 21 – 22, 25 – 27, and 29, as amended, meet all the requirements of 35 U.S.C. §101.

### **III. Rejections Under 35 U.S.C. §112, First Paragraph**

The Office Action indicates that claims 1 – 4, 6 – 11, 13 – 19, 21 – 27, and 29 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to adequately teach one of ordinary skill in the art how to make or use the invention, (*i.e.*, allegedly failing to disclose the support in reference to “first second third and fourth users” as described in claimed language of claims 1 – 4, 6 – 11, 13 – 19, 21 – 27, and 29). Applicant respectfully disagrees with this rejection. More specifically, FIGS. 2, 3A, and 3B, and associated description clearly describe an environment to satisfy the enablement requirement under 35 U.S.C. §112 ¶1.

Further, in response to the Office Action’s assertion that “Applicant’s disclosure did not even include the term ‘format server’, first format string’, [or] ‘second format string’ in the disclosure” (OA page 5, line 12), Applicant submits that these terms are not recited in any claim. Accordingly, Applicant submits that this rejection is misplaced.

Additionally, the Office Action indicates that claims 24 and 27 stand rejected under 35 U.S.C. §112, first paragraph “for reasons set forth in the objection to the specification” (page 5, element 9). Applicant traverses this rejection for at least the reason that the Office Action objects to no pending claims (see Office Action Summary, element 7).

### **IV. Rejections Under 35 U.S.C. §112, Second Paragraph**

Additionally, the Office Action indicates that claims 16 – 19, 21 – 22, 25 – 27, and 29 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite as the phrase “adapted to” renders the claim indefinite in its entirety. Applicant amends claims 16 – 19, 21 – 22, 25 – 27, and 29, and submit that these amendments fully comply with the requirements of 35 U.S.C. §112 ¶2.

**V. Rejections Under 35 U.S.C. §103**

**A. Claim 1 is Allowable Over *Couts* in view of *Morris***

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0120805 A1 ("*Couts*") in view of U.S. Patent Number 6,496,851 B1 ("*Morris*"). Applicant respectfully traverses this rejection for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claims 1. More specifically, claim 1 recites:

A communication method comprising:  
receiving an instant messaging (IM) message from a first user to a second user;  
prompting the first user for permission to convey the IM message to a third user;  
determining whether the second user is currently engaged in an IM chat session with a fourth user; and  
***indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.***

***(Emphasis added).***

Applicant respectfully submits that claim 1 is allowable over the cited art for at least the reason that neither *Couts* nor *Morris*, taken alone or in combination, discloses, teaches, or suggests a "communication method comprising... ***indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***" as recited in claim 1. More specifically, the Office Action admits "*Couts* however, is silent in indicating to the first user, that the second user is engaged in an IM chat session with the four user" (OA page 7, line 1).

Further, *Morris* fails to overcome the deficiencies of *Couts*. More specifically, the Office Action argues "*Morris*, FIG. 13, element-1300, [column 12,] lines 37 – 43 [discloses a system] where [a] message display as a user has declined your chat invitation, where [the] user can be

third, fourth, etc. [user] and [the] invitation can be due to various reasons e.g., busy, offline or not interested in [the] proposal” (OA page 7, line 5). Applicant respectfully disagrees. More specifically, *Morris* discloses “[i]n FIG. 13, the proposal originator has received the rejection message 1300 from the proposal recipient. Because this rejection message 1300 is by definition a Client Error message type, the proposal originator does not have the opportunity to ‘evil’ the recipient, even though the proposal was rejected” (column 12, line 37). As illustrated in this passage, *Morris* appears to simply disclose that a popup window can be displayed to indicate that a chat room invitation has been declined. There is not even a suggestion that the popup window in *Morris* could even be configured to indicate that the second user is engaged in an IM chat session with a fourth user, as recited in claim 1. In fact, the Office Action admits that there is no such suggestion by speculating that the reason that the user declined the chat invitation “can be due to various reasons e.g., busy, offline or not interested in [the] proposal” (*Morris*, column 12, line 37). Consequently, the rejection is improper. For at least this reason, claim 1 is allowable.

**B. Claim 9 is Allowable Over *Couts* in view of *Morris***

The Office Action indicates that claim 9 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0120805 A1 (“*Couts*”) in view of U.S. Patent Number 6,496,851 B1 (“*Morris*”). Applicant respectfully traverses this rejection for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claims 9. More specifically, claim 9 recites:

A communication method comprising:  
receiving an instant messaging (IM) message from a first user to a second user;  
conveying the IM message to a third user;  
determining whether the second user is currently engaged in an IM chat session with a fourth user; and  
***indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a***

***fourth user, that the second user is engaged in an IM chat session with the fourth user.***  
***(Emphasis added).***

Applicant respectfully submits that claim 9 is allowable over the cited art for at least the reason that neither *Couts* nor *Morris*, taken alone or in combination, discloses, teaches, or suggests a “communication method comprising... ***indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***” as recited in claim 9. More specifically, the Office Action admits “*Couts* however, is silent in indicating to the first user, that the second user is engaged in an IM chat session with the four user” (OA page 7, line 1).

Further, *Morris* fails to overcome the deficiencies of *Couts*. More specifically, the Office Action argues “*Morris*, FIG. 13, element-1300, [column 12,] lines 37 – 43 [discloses a system] where [a] message display as a user has declined your chat invitation, where [the] user can be third, fourth, etc. [user] and [the] invitation can be due to various reasons e.g., busy, offline or not interested in [the] proposal” (OA page 7, line 5). Applicant respectfully disagrees. More specifically, *Morris* discloses “[i]n FIG. 13, the proposal originator has received the rejection message 1300 from the proposal recipient. Because this rejection message 1300 is by definition a Client Error message type, the proposal originator does not have the opportunity to ‘evil’ the recipient, even though the proposal was rejected” (column 12, line 37). As illustrated in this passage, *Morris* appears to simply disclose that a popup window can be displayed to indicate that a chat room invitation has been declined. There is not even a suggestion that the popup window in *Morris* could even be configured to indicate that the second user is engaged in an IM chat session with a fourth user, as recited in claim 9. In fact, the Office Action admits that there is no such suggestion by speculating that the reason that the user declined the chat invitation “can be due to various reasons e.g., busy, offline or not interested in [the] proposal”

(*Morris*, column 12, line 37). Consequently, the rejection is improper. For at least this reason, claim 9 is allowable.

**C. Claim 14 is Allowable Over *Couts* in view of *Morris***

The Office Action indicates that claim 14 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0120805 A1 (“*Couts*”) in view of U.S. Patent Number 6,496,851 B1 (“*Morris*”). Applicant respectfully traverses this rejection for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claims 14. More specifically, claim 14 recites:

A communication system comprising:  
receive logic configured to receive an instant messaging (IM) message from a first user to a second user;  
prompting logic configured to prompt the first user for permission to convey the IM message to a third user;  
determining logic configured to determine whether the second user is currently engaged in an IM chat session with a fourth user; and

***indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.***

***(Emphasis added).***

Applicant respectfully submits that claim 14 is allowable over the cited art for at least the reason that neither *Couts* nor *Morris*, taken alone or in combination, discloses, teaches, or suggests a “communication system comprising... ***indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***” as recited in claim 14. More specifically, the Office Action admits “*Couts* however, is silent in indicating to the first user, that the second user is engaged in an IM chat session with the four user” (OA page 7, line 1).

Further, *Morris* fails to overcome the deficiencies of *Couts*. More specifically, the Office Action argues “*Morris*, FIG. 13, element-1300, [column 12,] lines 37 – 43 [discloses a system]

where [a] message display as a user has declined your chat invitation, where [the] user can be third, fourth, *etc.* [user] and [the] invitation can be due to various reasons *e.g.*, busy, offline or not interested in [the] proposal” (OA page 7, line 5). Applicant respectfully disagrees. More specifically, *Morris* discloses “[i]n FIG. 13, the proposal originator has received the rejection message 1300 from the proposal recipient. Because this rejection message 1300 is by definition a Client Error message type, the proposal originator does not have the opportunity to ‘evil’ the recipient, even though the proposal was rejected” (column 12, line 37). As illustrated in this passage, *Morris* appears to simply disclose that a popup window can be displayed to indicate that a chat room invitation has been declined. There is not even a suggestion that the popup window in *Morris* could even be configured to indicate that the second user is engaged in an IM chat session with a fourth user, as recited in claim 14. In fact, the Office Action admits that there is no such suggestion by speculating that the reason that the user declined the chat invitation “can be due to various reasons *e.g.*, busy, offline or not interested in [the] proposal” (*Morris*, column 12, line 37). Consequently, the rejection is improper. For at least this reason, claim 14 is allowable.

**D. Claim 15 is Allowable Over *Couts* in view of *Morris***

The Office Action indicates that claim 15 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0120805 A1 (“*Couts*”) in view of U.S. Patent Number 6,496,851 B1 (“*Morris*”). Applicant respectfully traverses this rejection for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claims 15. More specifically, claim 15 recites:

A communication system comprising:  
means for receiving an instant messaging (IM) message  
from a first user to a second user;  
means for prompting the first user for permission to convey  
the IM message to a third user;  
means for determining whether the second user is  
currently engaged in an IM chat session with a fourth user; and

***means for indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.***  
***(Emphasis added).***

Applicant respectfully submits that claim 15 is allowable over the cited art for at least the reason that neither *Couts* nor *Morris*, taken alone or in combination, discloses, teaches, or suggests a “communication system comprising... ***means for indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***” as recited in claim 15. More specifically, the Office Action admits “*Couts* however, is silent in indicating to the first user, that the second user is engaged in an IM chat session with the fourth user” (OA page 7, line 1).

Further, *Morris* fails to overcome the deficiencies of *Couts*. More specifically, the Office Action argues “*Morris*, FIG. 13, element-1300, [column 12,] lines 37 – 43 [discloses a system] where [a] message display as a user has declined your chat invitation, where [the] user can be third, fourth, etc. [user] and [the] invitation can be due to various reasons e.g., busy, offline or not interested in [the] proposal” (OA page 7, line 5). Applicant respectfully disagrees. More specifically, *Morris* discloses “[i]n FIG. 13, the proposal originator has received the rejection message 1300 from the proposal recipient. Because this rejection message 1300 is by definition a Client Error message type, the proposal originator does not have the opportunity to ‘evil’ the recipient, even though the proposal was rejected” (column 12, line 37). As illustrated in this passage, *Morris* appears to simply disclose that a popup window can be displayed to indicate that a chat room invitation has been declined. There is not even a suggestion that the popup window in *Morris* could even be configured to indicate that the second user is engaged in an IM chat session with a fourth user, as recited in claim 15. In fact, the Office Action admits that there is no such suggestion by speculating that the reason that the user declined the chat invitation “can be due to various reasons e.g., busy, offline or not interested in [the] proposal”



(*Morris*, column 12, line 37). Consequently, the rejection is improper. For at least this reason, claim 15 is allowable.

**E. Claim 16 is Allowable Over *Couts* in view of *Morris***

The Office Action indicates that claim 16 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0120805 A1 (“*Couts*”) in view of U.S. Patent Number 6,496,851 B1 (“*Morris*”). Applicant respectfully traverses this rejection for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claims 16. More specifically, claim 16 recites:

A computer-readable medium that stores a program that, when executed by a computer, causes the computer to perform at least the following:

receive an instant messaging (IM) message from a first user to a second user;

prompt the first user for permission to convey the IM message to a third user;

determine whether the second user is currently engaged in an IM chat session with a fourth user; and

***indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.***

***(Emphasis added).***

Applicant respectfully submits that claim 16 is allowable over the cited art for at least the reason that neither *Couts* nor *Morris*, taken alone or in combination, discloses, teaches, or suggests a “computer-readable medium that stores a program that, when executed by a computer, causes the computer to perform at least the following... ***indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***” as recited in claim 16. More specifically, the Office Action admits “*Couts* however, is silent in indicating to the first user, that the second user is engaged in an IM chat session with the four user” (OA page 7, line 1).

Further, *Morris* fails to overcome the deficiencies of *Couts*. More specifically, the Office Action argues “*Morris*, FIG. 13, element-1300, [column 12,] lines 37 – 43 [discloses a system] where [a] message display as a user has declined your chat invitation, where [the] user can be third, fourth, etc. [user] and [the] invitation can be due to various reasons e.g., busy, offline or not interested in [the] proposal” (OA page 7, line 5). Applicant respectfully disagrees. More specifically, *Morris* discloses “[i]n FIG. 13, the proposal originator has received the rejection message 1300 from the proposal recipient. Because this rejection message 1300 is by definition a Client Error message type, the proposal originator does not have the opportunity to ‘evil’ the recipient, even though the proposal was rejected” (column 12, line 37). As illustrated in this passage, *Morris* appears to simply disclose that a popup window can be displayed to indicate that a chat room invitation has been declined. There is not even a suggestion that the popup window in *Morris* could even be configured to indicate that the second user is engaged in an IM chat session with a fourth user, as recited in claim 16. In fact, the Office Action admits that there is no such suggestion by speculating that the reason that the user declined the chat invitation “can be due to various reasons e.g., busy, offline or not interested in [the] proposal” (*Morris*, column 12, line 37). Consequently, the rejection is improper. For at least this reason, claim 16 is allowable.

**F. Claim 23 is Allowable Over *Couts* in view of *Morris***

The Office Action indicates that claim 23 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0120805 A1 (“*Couts*”) in view of U.S. Patent Number 6,496,851 B1 (“*Morris*”). Applicant respectfully traverses this rejection for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claims 23. More specifically, claim 23 recites:

A communication system comprising:  
receive logic configured to receive an instant messaging  
(IM) message from a first user to a second user;

conveying logic configured to convey the IM message to a third user;

determining logic configured to determine whether the second user is currently engaged in an IM chat session with a fourth user; and

***indicating logic configured to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.***

***(Emphasis added).***

Applicant respectfully submits that claim 23 is allowable over the cited art for at least the reason that neither *Couts* nor *Morris*, taken alone or in combination, discloses, teaches, or suggests a “communication system comprising... ***indicating logic configured to indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***” as recited in claim 23. More specifically, the Office Action admits “*Couts* however, is silent in indicating to the first user, that the second user is engaged in an IM chat session with the four user” (OA page 7, line 1).

Further, *Morris* fails to overcome the deficiencies of *Couts*. More specifically, the Office Action argues “*Morris*, FIG. 13, element-1300, [column 12,] lines 37 – 43 [discloses a system] where [a] message display as a user has declined your chat invitation, where [the] user can be third, fourth, etc. [user] and [the] invitation can be due to various reasons e.g., busy, offline or not interested in [the] proposal” (OA page 7, line 5). Applicant respectfully disagrees. More specifically, *Morris* discloses “[i]n FIG. 13, the proposal originator has received the rejection message 1300 from the proposal recipient. Because this rejection message 1300 is by definition a Client Error message type, the proposal originator does not have the opportunity to ‘evil’ the recipient, even though the proposal was rejected” (column 12, line 37). As illustrated in this passage, *Morris* appears to simply disclose that a popup window can be displayed to indicate that a chat room invitation has been declined. There is not even a suggestion that the popup window in *Morris* could even be configured to indicate that the second user is engaged in

an IM chat session with a fourth user, as recited in claim 23. In fact, the Office Action admits that there is no such suggestion by speculating that the reason that the user declined the chat invitation “can be due to various reasons e.g., busy, offline or not interested in [the] proposal” (*Morris*, column 12, line 37). Consequently, the rejection is improper. For at least this reason, claim 23 is allowable.

**G. Claim 24 is Allowable Over *Couts* in view of *Morris***

The Office Action indicates that claim 24 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0120805 A1 (“*Couts*”) in view of U.S. Patent Number 6,496,851 B1 (“*Morris*”). Applicant respectfully traverses this rejection for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claims 24. More specifically, claim 24 recites:

A communication system comprising:  
means for receiving an instant messaging (IM) message  
from a first user to a second user;  
means for conveying the IM message to a third user;  
means for determining whether the second user is  
currently engaged in an IM chat session with a fourth user; and  
***means for indicating to the first user, in response to  
determining that the second user is engaged in an IM chat  
session with a fourth user, that the second user is engaged in  
an IM chat session with the fourth user.***

***(Emphasis added).***

Applicant respectfully submits that claim 24 is allowable over the cited art for at least the reason that neither *Couts* nor *Morris*, taken alone or in combination, discloses, teaches, or suggests a “communication system comprising... ***means for indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***” as recited in claim 24. More specifically, the Office Action admits “*Couts* however, is silent in indicating to the first user, that the second user is engaged in an IM chat session with the four user” (OA page 7, line 1).

Further, *Morris* fails to overcome the deficiencies of *Couts*. More specifically, the Office Action argues “*Morris*, FIG. 13, element-1300, [column 12,] lines 37 – 43 [discloses a system] where [a] message display as a user has declined your chat invitation, where [the] user can be third, fourth, etc. [user] and [the] invitation can be due to various reasons e.g., busy, offline or not interested in [the] proposal” (OA page 7, line 5). Applicant respectfully disagrees. More specifically, *Morris* discloses “[i]n FIG. 13, the proposal originator has received the rejection message 1300 from the proposal recipient. Because this rejection message 1300 is by definition a Client Error message type, the proposal originator does not have the opportunity to ‘evil’ the recipient, even though the proposal was rejected” (column 12, line 37). As illustrated in this passage, *Morris* appears to simply disclose that a popup window can be displayed to indicate that a chat room invitation has been declined. There is not even a suggestion that the popup window in *Morris* could even be configured to indicate that the second user is engaged in an IM chat session with a fourth user, as recited in claim 24. In fact, the Office Action admits that there is no such suggestion by speculating that the reason that the user declined the chat invitation “can be due to various reasons e.g., busy, offline or not interested in [the] proposal” (*Morris*, column 12, line 37). Consequently, the rejection is improper. For at least this reason, claim 24 is allowable.

**H. Claim 25 is Allowable Over *Couts* in view of *Morris***

The Office Action indicates that claim 25 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0120805 A1 (“*Couts*”) in view of U.S. Patent Number 6,496,851 B1 (“*Morris*”). Applicant respectfully traverses this rejection for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claims 25. More specifically, claim 25 recites:

A computer-readable medium that includes a computer program that, when executed by a computer, causes the computer to perform at least the following:

receive an instant messaging (IM) message from a first user to a second user;  
convey the IM message to a third user;  
determine whether the second user is currently engaged in an IM chat session with a fourth user; and  
***indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user.***

***(Emphasis added).***

Applicant respectfully submits that claim 24 is allowable over the cited art for at least the reason that neither *Couts* nor *Morris*, taken alone or in combination, discloses, teaches, or suggests a “computer-readable medium that includes a computer program that, when executed by a computer, causes the computer to perform at least the following... ***indicate to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user***” as recited in claim 24. More specifically, the Office Action admits “*Couts* however, is silent in indicating to the first user, that the second user is engaged in an IM chat session with the four user” (OA page 7, line 1).

Further, *Morris* fails to overcome the deficiencies of *Couts*. More specifically, the Office Action argues “*Morris*, FIG. 13, element-1300, [column 12,] lines 37 – 43 [discloses a system] where [a] message display as a user has declined your chat invitation, where [the] user can be third, fourth, etc. [user] and [the] invitation can be due to various reasons e.g., busy, offline or not interested in [the] proposal” (OA page 7, line 5). Applicant respectfully disagrees. More specifically, *Morris* discloses “[i]n FIG. 13, the proposal originator has received the rejection message 1300 from the proposal recipient. Because this rejection message 1300 is by definition a Client Error message type, the proposal originator does not have the opportunity to ‘evil’ the recipient, even though the proposal was rejected” (column 12, line 37). As illustrated in this passage, *Morris* appears to simply disclose that a popup window can be displayed to indicate that a chat room invitation has been declined. There is not even a suggestion that the

popup window in *Morris* could even be configured to indicate that the second user is engaged in an IM chat session with a fourth user, as recited in claim 24. In fact, the Office Action admits that there is no such suggestion by speculating that the reason that the user declined the chat invitation “can be due to various reasons e.g., busy, offline or not interested in [the] proposal” (*Morris*, column 12, line 37). Consequently, the rejection is improper. For at least this reason, claim 24 is allowable.

**I. Claims 2 – 4, 6 – 8, 10 – 11, 13, 17 – 19, 21 – 22, 26 – 27, and 29 are Allowable Over *Couts* in view of *Morris***

The Office Action indicates that claims 2 – 4, 6 – 8, 10 – 11, 13, 17 – 19, 21 – 22, 26 – 27, and 29 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Publication Number 2003/0120805 A1 (“*Couts*”) in view of U.S. Patent Number 6,496,851 B1 (“*Morris*”). Applicant respectfully traverses this rejection for at least the reason that *Couts* in view of *Morris* fails to disclose, teach, or suggest all of the elements of claims 2 – 4, 6 – 8, 10 – 11, 13, 17 – 19, 21 – 22, 26 – 27, and 29. More specifically, dependent claims 2 – 4 and 6 – 8 are believed to be allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 1. Further, dependent claims 10 – 11 and 13 are believed to be allowable for at least the reason that they depend from and include the elements of allowable independent claim 9. Dependent claims 17 – 19 and 21 – 22 are believed to be allowable for at least the reason that they depend from and include the elements of allowable independent claim 16. Dependent claims 26 – 27 and 29 are believed to be allowable for at least the reason that they depend from and include the elements of allowable independent claim 25. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

**VI. Allegedly Inherent Subject Matter**

In addition, the Office Action states “Couts discloses the invention substantially, including, receiving an instant messaging (IM) message from a first user to a second user ([0024, lines 2-41, where communication message is inherently an instant message...)]” (OA page 6, line 15). Applicants respectfully traverse the finding of inherency. It is well established that “[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In Re Anthony J. Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999).

Applicants respectfully submit that the Office Action fails to adequately establish that the subject matter of the rejected claims is necessarily present. As the Office Action fails to provide any extrinsic evidence that makes clear that the missing descriptive matter is necessarily present, Applicants respectfully submit that inherency has not been established. In accordance with *In re Robertson*, Applicants traverse the inherency finding, and submit that the pending claims are allowable over the cited art.



### **CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, all objections and/or rejections have been traversed, rendered moot, and/or addressed, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/afb/

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